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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,710	12/14/2001	Jan Bertrem	CM2147M	9841

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EXAMINER

MRUK, BRIAN P

ART UNIT PAPER NUMBER

1751

DATE MAILED: 10/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/020,710

Applicant(s)

BERTREM ET AL.

Examiner

Brian P Mruk

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondenc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 7-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 7-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 11.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. This Office action is in response to Applicant's amendment filed June 12, 2003.

Applicant has amended claims 1-4 and 12. Claims 5-6 have been cancelled. New claim 19 has been added. Currently, claims 1-4 and 7-19 remain pending in the application.

2. The text of those sections of Title 35 U.S. Code not included in this action can be found in the prior Office action, Paper No. 6.

3. The objection of the specification for containing an improper use of trademarks is withdrawn in view of applicant's amendments and remarks.

4. The objection of claims 2-15 is withdrawn in view of applicant's amendments and remarks. Specifically, applicant has corrected the grammatical informality in instant claim 2, has amended claim 3 to further limit claim 2, and has cancelled claim 5.

5. The rejection of claims 1-4 and 7-18 under 35 U.S.C. 112, second paragraph, for containing the phrase "less than about" is maintained for the reasons of record.

6. The rejection of claims 3-5 and 12 under 35 U.S.C. 112, second paragraph, is withdrawn in view of applicant's amendments and remarks. Specifically, applicant has

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amended instant claims 3-4 to recite the rinse test method steps, has cancelled claim 5, and has amended claim 12 to remove the "preferably" clause.

7. The rejection of claims 1-4, 7-10 and 16 under 35 U.S.C. 102(a) as being anticipated by Gordon et al, EP 859,046 A1, is withdrawn in view of applicant's amendments and remarks. Specifically, applicant has amended claim 1 to require the composition to have a pH of less than 9, which is not taught by Gordon et al, EP 859,046 A1.

8. The rejection of claims 1-4, 7-10 and 16-18 under 35 U.S.C. 102(a) as being anticipated by Pace et al, EP 919,610 A1, is maintained for the reasons of record.

9. The rejection of claims 1-4, 7-10 and 12 under 35 U.S.C. 102(b) as being anticipated by Willey et al, WO 97/33963, is maintained for the reasons of record.

10. The rejection of claims 1-4, 7-10, 12, 16 and 18 under 35 U.S.C. 102(b) as being anticipated by Fusiak et al, WO 95/00611, is maintained for the reasons of record.

11. The rejection of claims 1-4, 7-10, 12, 16 and 17 under 35 U.S.C. 102(b) as being anticipated by Aronson et al, U.S. Patent No. 4,368,146, is maintained for the reasons of record.

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12. The rejection of claims 1-4 and 7-14 under 35 U.S.C. 102(b) as being anticipated by Spruyt et al, WO 97/03180, is maintained for the reasons of record.

13. The rejection of claims 11-15 under 35 U.S.C. 103(a) as being unpatentable over Gordon et al, EP 859,046 A1, is withdrawn in view of applicant's amendments and remarks. Specifically, applicant has amended claim 1 to require the composition to have a pH of less than 9, which is not taught by Gordon et al, EP 859,046 A1.

14. The rejection of claims 11-12 under 35 U.S.C. 103(a) as being unpatentable over Pace et al, EP 919,610 A1, is maintained for the reasons of record.

15. The rejection of claims 1-4, 7, 9-11 and 13 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 10/020,600, is maintained for the reasons of record.

NEW GROUNDS OF REJECTION

Specification

16. The amendment filed June 12, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The examiner notes that

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applicant does not have support for a composition having a pH of less than 9, as recited in newly amended claim 1. Specifically, the examiner notes that page 37 of the instant specification states that the pH of the composition is neutral, typically from 4.0-9.0, preferably from 4.5-9.5. Thus, the specification does not provide support for a pH range of less than 4.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

17. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

18. Claims 1-4 and 7-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The examiner notes that applicant does not have support for a composition having a pH of less than 9, as recited in newly amended claim 1. Specifically, the examiner notes that page 37 of the instant specification states that the pH of the composition is neutral, typically from 4.0-9.0, preferably from 4.5-9.5. Thus, the specification does not provide support for a pH range of less than 4.

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19. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

20. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Newly added claim 19 is rejected under 35 U.S.C. 112, second paragraph, for being dependent upon a claim with the above addressed 112 problem (i.e. claim 1).

Claim Rejections - 35 USC § 102

21. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

22. Claim 19 is rejected under 35 U.S.C. 102(a) as being anticipated by Pace et al, EP 919,610 A1, for the reasons of record found in the last Office action, Paper No. 6, Paragraph No. 17.

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23. Claim 19 is rejected under 35 U.S.C. 102(b) as being anticipated by Willey et al, WO 97/33963, for the reasons of record found in the last Office action, Paper No. 6, Paragraph No. 18.

24. Claim 19 is rejected under 35 U.S.C. 102(b) as being anticipated by Fusiak et al, WO 95/00611, for the reasons of record found in the last Office action, Paper No. 6, Paragraph No. 19.

25. Claim 19 is rejected under 35 U.S.C. 102(b) as being anticipated by Aronson et al, U.S. Patent No. 4,368,146, for the reasons of record found in the last Office action, Paper No. 6, Paragraph No. 20.

26. Claim 19 is rejected under 35 U.S.C. 102(b) as being anticipated by Spruyt et al, WO 97/03180, for the reasons of record found in the last Office action, Paper No. 6, Paragraph No. 21.

Double Patenting

27. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

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patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

28. Claim 19 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 10/020,600, for the reasons of record found in the last Office action, Paper No. 6, Paragraph No. 26.

Response to Arguments

29. Applicant's arguments filed June 12, 2003 have been fully considered but they are not persuasive.

Applicant argues that the phrase "less than about" in instant claims 1 and 2 does not render the claims indefinite, since over 46,600 U.S patents recite the phrase "less than about" in the claims. However, the examiner asserts that this phrase renders the claim vague and indefinite, since one of ordinary skill in the art would not be able to ascertain the metes and bounds of the phrase "less than about". It is unclear what values are encompassed by the phrase "less than about". Furthermore, the examiner asserts that since instant claims 1-2, which contain the phrase "less than about", have been rejected by prior art, that close prior art does exist. Regarding the 46,600 U.S patents that recite the phrase "less than about" in the claims, the examiner asserts that since he does not know the prosecution history of these patents that he cannot comment on these issued patents.

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Applicant argues that Pace et al, EP 919,610 A1, Willey et al, WO 97/33963, Fusiak et al, WO 95/00611, Aronson et al, U.S. Patent No. 4,368,146, and Spruyt et al, WO 97/03180 do not teach that the cleaning composition is for cleaning the exterior surface of a vehicle. However, the examiner asserts that the phrases "A cleaning composition for cleaning exterior surfaces of a vehicle," and "wherein said polymer modifies at least a portion of an exterior surface of a vehicle" in instant claims 1 and 2 sets forth an intended use of the composition without adding structure. Therefore, since the preambles of instant claims 1 and 2 do not breath life and meaning into the claims, the surfaces recited in instant claims 1-2 are being treated as a statement of intended use and not as a limitation, and thus are not accorded any patentable weight. See **MPEP 2111.02**. Furthermore, the examiner suggests that applicant should formulate method claims that incorporate the surfaces treated in order for these phrases to obtain patentable weight.

Conclusion

30. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

31. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Mruk whose telephone number is (703) 305-0728. The examiner can normally be reached on Monday-Thursday from 7:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta, can be reached on (703) 308-4708. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 (Before Final) and (703) 872-9311 (After Final).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Bm

Brian Mruk
October 17, 2003

Brian P. Mruk

Brian P. Mruk
Patent Examiner
Tech Center 1700